

REMARKS

I. Introduction

Claims 11, 12, 16 and 18 are pending in this application. Claim 11 has been amended. Reconsideration of the present application in view of the foregoing amendments and following remarks is respectfully requested.

II. Rejection of Claims 11, 12, 16 and 18 Under 35 U.S.C. § 103(a)

Claims 11, 12, 16 and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Unexamined Patent Application Publication No. 2001198141 ("Kudo et al.") in view of U.S. Patent No. 6,081,371 ("Shioda et al.") and Japanese Unexamined Patent Application Publication No. 2001299695 ("Nakanishi et al."). Applicants respectfully submit that the combination of Kudo et al., Shioda et al. and Nakanishi et al. does not render these claims unpatentable for at least the following reasons.

Claim 11 relates to a microscopic observing apparatus comprising: a probe microscope; an auxiliary microscope; a specimen stage on which is placed a subject of observation that is to be observed using the probe microscope and the auxiliary microscope, and that allows an absolute position of the subject of observation to be adjusted; a laser light irradiation device that irradiates laser light that is coaxial with the optical axis of the probe microscope onto the subject of observation; and a microscope holding member that holds both of the probe microscope and the auxiliary microscope on the specimen stage, wherein the microscope holding member includes: an arm that extends horizontally towards an above of the specimen stage, and holds the probe microscope; and a rotatable member that is rotatably attached to a distal end of the arm so as to be rotatable around a horizontal axis, and holds the auxiliary microscope.

Although Applicants may not agree with the merits of the rejection, to simplify matters, Claim 11 has been amended for clarification purposes, to correct a syntax error and to incorporate an additional feature. Specifically, claim 11 as amended recites, in relevant parts, that *the microscope holding member includes: an arm that extends horizontally towards an area above the specimen stage; and a rotatable member that is rotatably attached to a distal end of the arm so as to be rotatable around a horizontal axis*, and that *the probe microscope is directly held by the arm, while the auxiliary microscope is held by the rotatable member so as to be rotatable therewith around the horizontal axis*. The latter feature advantageously allows an operator to easily and directly view an operation area of the

subject of operation immediately, as necessary, by displacing and rotating the auxiliary microscope from its observation position, together with the rotatable member, about the horizontal axis, *without changing the position of the probe microscope*. In addition, the operator can return the auxiliary microscope to its original observation position by rotating it, *without changing the position of the probe microscope*. Support for these amendments may be found, for example, on page 66, line 18 and from page 66, line 23 to page 67, line 3 of the Specification, as well as in Fig. 24.

Neither Kudo et al., nor Shiota et al., nor Nakanishi et al. disclose, or even suggest, a probe microscope that is directly held by an arm, and an auxiliary microscope that is held by a rotatable member rotatably attached to a distal end of the arm, so that the auxiliary microscope can rotate, together with the rotatable member, about a horizontal axis. Kudo et al. do describe an operating area observation system for observing the image of the operating area of a patient undergoing surgery. The system includes an operation microscope (1), which in turn includes, inter alia, a base (4), stanchion (5), first arm (6), second arm (7), third arm (8), mirror body (2), multijoint manipulator (21), TV camera (34) and a rigid mirror (33). *However, as is apparent from Fig. 1 of Kudo et al., the rigid mirror (33), which the Office Action equates with the probe microscope of claim 11, is not directly held by the second arm (7), which the Office Action equates with the arm of claim 11, but is merely indirectly attached to the second arm (7) via multijoint manipulator (21), mirror body (2) and third arm (8)*. Since the rigid mirror (33) is not directly held by the second arm (7), when an operator displaces and rotates the mirror body (2) from its observation position, together with the third arm (8), about a horizontal axis O₄, the rigid mirror (33) is moved together with the mirror body (2). Thus, it is impossible to move the mirror body (2) from its observation position *without changing the position of the mirror body (2)*. Accordingly, it is respectfully submitted that the combination of Kudo et al., Shiota et al. an Nakanishi et al. does not render claim 11 unpatentable for at least these reasons.

As for claims 12, 16 and 18, which ultimately depend from claim 11 and therefore include all of the features of claim 11, it is respectfully submitted that the combination of Kudo et al., Shiota et al. an Nakanishi et al. does not render these dependent claims unpatentable for at least the reasons more fully set forth above in support of the patentability of claim 11.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicants respectfully submit that pending claims 11, 12, 16 and 18 of the present application under consideration are now in condition for allowance.

Respectfully submitted,

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KENYON & KENYON LLP
Richard M. Rosati (Reg. No. 31,792)
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646